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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,262	08/27/2003	Yoshiakira Yokoyama	56937-085	5228

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Washington, DC 20005-3096

EXAMINER

DEBROW, JAMES J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/648,262	YOKOYAMA ET AL.	
	Examiner	Art Unit	
	James J. Debrow	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communication: Request for Continue Examination (RCE) filed 26 Oct 2006.
2. Independent Claim 1 is pending in this case.

Applicant's Response

3. In Applicant's response dated 26 Oct 2006, Applicant amended Claim 1, cancelled claim 2, and argued against all objections and rejection previously set forth in previous Office Action.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 Oct 2006 has been entered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claim 1** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Line 3, 8, and 11 recites Applicant amendment *character train variable [[and] or a data variable*, which is not supported by the specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claim 1** recites the limitation "*the target document*" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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10. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sampath et al. (US 2002/0169803 A1; Filled Dec. 5, 2001) (hereinafter "Sampath").

In regards to independent claim 1, Sampath discloses a *document creation support system comprising:*

a database unit constructed by a template database part including document information of a template document in which a character train variable or a data variable with a tag are embedded, and a variable-content database part including a group of database components with tags (0036; 0040; 0046; 112, 114, & 115 in Fig 1b; Sampath discloses the Document Generator consists of three modules, a structure template transformer module, which takes document specifications as input and restructures, translates and instantiates the specifications into a structured document template (*template database part*); a document content filling operator module, which takes the document template as input and queries the database to fill the placeholders (*character train variables or data variable with a tag*), and attribute placeholders inside the template; a document maker module, which takes the generated document and publish it in a browseable book or file.).

an input interface unit for inputting parameter information instructing a description change part in a target document with respect to the template document (0023 - 0025; 401 in Fig 4; 404 in Fig 4; Sampath discloses a system for generating structured documents via a graphical user interface. Through the graphical interface, the user can

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input parameters to select the desired presentation, specifications, and format of the document from information derived from a database.);

a variable converting unit for defining the character train variable or the data variable with a tag on the basis of the input parameter information (0023-0025; 0041-0045);

an entity referring unit for searching the template database part and the variable-content database part on the basis of the character train variable or the data variable with a tag (0040; 0046-49; Sampath discloses a method of a search sequence parsing the structure of the document identifying variable-value pairs. The Examiner concludes that Sampath teaching can be used by one of ordinary skill in the art for searching the template database part and the variable-content database part on the basis of the character train variable or the data variable with a tag.).

a synthesizing unit for instantiating the character train variable in the template document retrieved by the search with the definition of the character train variable, instantiating the data variable with a tag in the template document with the tagged database component retrieved by the search, and synthesizing the resultants, thereby creating the target document (0036; 0040; 0046; 112, 114, & 115 in Fig 1b; Sampath discloses the Document Generator consists of three modules, a structure template transformer module, which takes document specifications as input and restructures, translates and instantiates the specifications into a structured document template (template database part); a document content filling operator module (synthesizing unit), which takes the document template as input and queries the database to fill the

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placeholders (*character train variables or data variable with a tag*), and attribute placeholders inside the template; a document maker module, which takes the generated document (*target document*) and publish it in a browseable book or file. Sampath also disclose the documents that are generated from the stored templates can be of several types, ie. SGML, XML, or HTML documents. It has been established that these type documents consists of character train variables, and data variable with embedded tags. Therefore, it can be concluded that the Sampath database unit and the current invention database unit are constructed similarly.).

wherein the database component with a tag in the variable-content database part has a nested structure in which a character train variable or a data variable with a tag are embedded (0036; 0045; Sampath discloses content placeholders and attribute placeholders, thus character train variables and data variable with a tag. At the time of the invention, it had been established and was well known in the art that tags within a document structure typically contained embedded character train variable or a data variable.).

Note

11. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Response to Arguments

12. Applicant's arguments filed 26 Oct 2006 have been fully considered but they are not persuasive.

Applicant states, *in order to overcome the Examiner's reliance on a "character train variable" and a "data variable with a tag" being non-distinguishable so as to read Sampath's disclosure of replacement values (see paragraph [0051] thereof) as both a "character train variable" and a "data variable with a tag, claim 1 has been further amended to differentiate between the two parameters. Specifically, "and" has been replaced with --or-- between the parameters to emphasis that a "character train variable" and a "data variable with a tag" are independent of each other so that the Examiner can no longer group them together as a single unit to read on Sampath's replacement values.*

The Examiner notes that by amending the claim(s) as described about, Applicant recites a broader claim than previously recited. Therefore, Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection as described about.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAMES DEBROW
EXAMINER
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